

REMARKS

In the Office Action claims 1-14 were rejected. By present response claims 7, 8, 9 and 12 have been amended. Upon entry of amendments, claims 1-14 will be pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

Rejections Under 35 U.S.C. § 112

In the Office Action, claims 1-14 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. From the office action, it is somewhat unclear whether the examiner intended to reject the claims based upon inoperative subject matter (see MPEP §2164.08(b)) or based upon what she considers a critical feature missing from the claims (see MPEP §2164.08(c)).

If the rejection is based on inoperative subject matter, Applicant's position is essentially the same as presented in response to the last Office Action. Electrical connection between a cathode of one repeatable fuel cell and the anode of another typically includes a cathodic interconnect having a separator plate to fluidically separate the oxidant from the fuel, and an anodic interconnect. The subject matter disclosed in the present application is operative *in its own claimed context*, which refers to the cooling apparatus and only certain relevant elements of the fuel cell.

Applicant's position finds support in the MPEP §2164.08(b), which reads in part:

The presence of inoperative embodiments within the scope of a claim does not necessarily render a claim nonenabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984) (prophetic examples do not make the disclosure nonenabling).

Indeed, this type of rejection does not appear relevant to the rejected claims. There is no doubt (at least none raised by the Examiner) that the claimed system is operative for the claimed purpose (cooling).

If the rejection is based upon a critical feature not being claimed, Applicant stresses that a separator plate (to fluidically separate the oxidant from the fuel) is not critical to the operation of a cooling apparatus as recited in claims 1 and 7. Here again, one skilled in the art would know how to incorporate the cooling apparatus of the present invention into a fuel cell stack having repeatable fuel cell units and having electrical connections comprising cathodic interconnects, cooling apparatus, separator plates and anodic interconnects. Indeed, the Examiner herself appears to fully appreciate that fact. MPEP §2164.08(c) provides, in part:

A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112. See *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976). In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

In the present case, many other components *could and would* be included in an actual fuel cell product. However, nothing in the Patent Statute, Rules or the MPEP requires that a claim recite all elements that would eventually be included in a manufactured product. The claims are not a blue print for a commercial product. In the present case, extraneous, unclaimed elements are not critical at all and are irrelevant to *the invention claimed*. As such, a rejection for lack of enablement or inoperability is improper.

New rejection based upon "at least one fuel cell"

In the Office Action, the examiner cited what is, in effect, a new basis for rejecting claim 7 and its dependents. That is, the Examiner stated that the reference to "at least one fuel cell" implied the need for a separator. This basis for the rejection was not made in the previous Office Action. If it had been, the claims could have been amended to overcome the particular rejection. In the present response, claims 7, 8, 9 and 12 have been amended to overcome this new basis for rejection. Applicant respectfully requests that these amendments be entered, to give Applicant a fair opportunity to respond, and at least to narrow the scope of issues for appeal. Moreover, because this particular basis for the rejection is new, Applicant hereby objects to the finality of the present Office Action and requests that its finality be withdrawn.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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